

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Serial No.: 10/034,642

Confirmation No.: 9543

Filed: December 28, 2001

For: POLYCRYSTALLINE TRANSLUCENT ALUMINA-BASED CERAMIC MATERIAL, USES, AND METHODS

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### Remarks

The Final Office Action mailed May 19, 2004 has been received and reviewed. Claims 44 and 59 having been amended, the pending claims are claims 1-61. Claims 44-61 having been withdrawn from consideration by the Examiner, the claims currently under examination are claims 1-43.

Independent method claims 44 and 59 have been amended to recite all the language of, for example, product claims 1 and 16, respectively.

Reconsideration and withdrawal of the rejections are respectfully requested.

### Interview Summary

Applicants thank Examiner Blackwell Rudasil for granting a telephonic interview with Applicants' Representative, Loren D. Albin, on September 9, 2004. The rejection under 35 U.S.C. §102(b) as being anticipated by European Patent Application No. 0 284 418 B1 (EP '418) was discussed. Applicants thank the Examiner for indicating that upon reconsideration, the Examiner determined that the rejection had been overcome by the traverse presented by Applicants in the Amendment and Response submitted on February 5, 2004, and for indicating that the rejection will be withdrawn.

### Obviousness-Type Double Patenting Rejection

Claims 29 and 31-43 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,648,638. Submitted herewith is a Terminal Disclaimer which, Applicants submit, is in compliance with 37 CFR 1.321(c), and thereby obviates the Examiner's double patenting rejection of pending claims.

Applicants respectfully request that the Examiner reconsider and withdraw the obviousness-type double patenting rejection.

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**Rejection under 35 U.S.C. §102**

The Examiner rejected claims 1-9 under 35 U.S.C. §102(b) as being anticipated by European Patent Application No. 0 284 418 B1 (EP '418). As discussed in the Interview Summary herein above, the Examiner indicated that the rejection has been overcome by the traverse presented by Applicants in the Amendment and Response submitted on February 5, 2004, and agreed that the rejection will be withdrawn. As such, withdrawal of the rejection is respectfully requested.

The Examiner rejected claims 1-16, 19-29, and 32-41 under 35 U.S.C. §102(e) as being anticipated by Yamamoto et al. (U.S. Patent No. 6,417,127). A Declaration Under 37 C.F.R. §1.131 is being submitted concurrently herewith in which Applicants Darren T. Castro and Richard P. Rusin swear that before May 19, 2000, which is the U.S. filing date of Yamamoto et al., they reduced to practice the present invention. In view of the Declaration Under 37 C.F.R. §1.131 submitted concurrently herewith, Applicants respectfully submit that Yamamoto et al. is not available as art under 35 U.S.C. §102(e).

In view of the remarks presented herein above, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §102.

**Rejection under 35 U.S.C. §103**

The Examiner rejected claims 1-43 under 35 U.S.C. §103(a) as being unpatentable over International Patent Application Publication No. 01/13862 (WO '862) in view of Yamamoto et al. (U.S. Patent No. 6,417,127). As described hereinabove, in view of the Declaration Under 37 C.F.R. §1.131 submitted concurrently herewith, Yamamoto et al. is unavailable as 35 U.S.C. §102(e) art for use in the rejection under 35 U.S.C. §103.

In view of the remarks presented herein above, Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §103.

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**Request for Rejoinder**

The Examiner has withdrawn method claims 44-61 from consideration. Applicants thank the Examiner for noting that if product claims are found to be allowable, withdrawn process claims, which depend from or otherwise include all the limitations of an allowable product claim will be considered for rejoinder. Applicants respectfully submit that method claims 44-61 recite all the language of, for example, product claims 1 and 16.

Applicants respectfully request that, upon indication of an allowable product claim, method claims 44-61 be rejoined and examined pursuant to M.P.E.P. §821.04. *See, for example, In re Ochiati*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996).

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
Darren T. CASTRO et al.

By

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September 20, 2004By: 

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Commissioner for Patents, Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20th day of September, 2004, at 5:06 p.m. (Central Time).

By: Name: Rachel Gagliardi-Albin